



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,222	12/28/2001	Richard S. Chernock	YOR920010442US1	9082
7590 Ryan, Mason & Lewis, LLP 90 Forest Avenue Locust Valley, NY 11560				
10/07/2008				
EXAMINER				
HOSSAIN, FARZANA E				
ART UNIT		PAPER NUMBER		
2424				
MAIL DATE		DELIVERY MODE		
10/07/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/034,222

Applicant(s)

CHERNOCK ET AL.

Examiner

FARZANA E. HOSSAIN

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11, 12, 17-20, 28, 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11, 12, 17-20, 28 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to communications filed 06/20/2008. Claims 1-6, 11, 12, 17-20, 28, 31 and 32 are pending.

Claim 1 is amended. Claims 2, 3, 5, 6, 11, 12 and 18-20 are original. Claims 4, 17, 28, 31, and 32 are previously presented. Claims 7-10, 13-16, 21-27, 29-30 and 33-49 are cancelled.

Response to Arguments

2. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Regarding Claim 1, the applicant argues that the cited references fail to teach new limitations.

In response to the arguments, the references of Claim 1 fail to teach the new limitations. However, cited references of dependent claims Barton and Tomsen in combination with the previous rejection of Claim meets the limitations of Claim 1. Barton discloses adding interactive content including a menu to the last commercial in a group of commercials (Pages 2-3, paragraphs 0036-0037). Tomsen discloses indications of previously broadcast content can be stored and collected via a shopping

cart or family safe at the storage locations or servers of Figures 1, 2 and 3. Therefore, the remaining limitations are met by Tomsen. Please see rejection.

Moreover, in KSR v. Teleflex Co. No. 04-1350, slip. op. at 12 (U.S. April 30, 2007), the Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 11, 12, 17, 19, 20, 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerba et al (US 5,931,908 and hereafter referred to as "Gerba") in view of Noll et al (US 2005/0132295 and hereafter referred to as "Noll"), Bruckner et al (US 2005/0015796 and hereafter referred to as "Bruckner"), Barton (US 2005/0273828) and Tomsen (US 2002/0016965).

Regarding Claim 1, Gerba discloses an apparatus (Figure 1, 2) for controlling interactive television offerings over a transaction-enabled (Column 1, lines 34-43, Column 9, lines 11-27) broadcast network (Figure 1, 30, 32), the apparatus comprising:

at least one central system processor (Figure 1, 12) of a multi service operator (MSO) (Column 5, lines 5-8) operative to: (i) receive broadcast content or programming from a content source or remote location (Figure 1, 4); (ii) process the broadcast content (Figure 1, 12, Column 7, lines 11-65); (iii) transmit the processed broadcast content over the network (Figure 1, 22) to a viewer or set top box (STB) (Figure 2, 34); (iv) receive request data or upstream communications over the network from the viewer (Figure 1, 24, Column 9, lines 11-27); and (v) process the request data, wherein the central system processor of a MSO is further operative as a central point of control for the request data (Figure 1, 12, Column 10, lines 43-48) or interactive content contained within the broadcast content (Figure 1, 12, Column 10, lines 43-48, Column 9, lines 11-27); and

memory (Figure 1, 14, 16, 18, 20), operatively coupled to the processor central system processor of a MSO (Figure 1, 12, Column 5, lines 5-8), for storing at least a portion of data related to least one of the receiving, transmitting and processing steps such as the received program is processed with received synchronization data, interface data and overlay sets which are stored in the memory (Figures 1, 2, 3a: 215, Column 9, lines 51-55) or storing the processed program (Figure 1, 20) or storing transaction data in the databases (Figure 1, 26). Gerba is silent on the central system processor collects information about viewer transactions for commerce purposes and the central system processor is further operative to add interactive advertizing content to non interactive advertising content for a period of time defined by at least one local merchant offer; wherein the non interactive advertising content is not originally created

for interactivity; wherein the at least one central system processor is further operative to route the request data to the at least one local merchant using at least one advertisement identifier, that adding interactive content of the commercial are placed at the last commercial of the group of commercials; the central system processor is further operative to collect and store previously broadcast interactive advertising content; wherein the central system processor is further operative to, responsive to the request data from the viewer, transmit the previously broadcast interactive advertising content to the viewer; wherein the central system processor is further operative to collect and store one or more indications of interest by the viewer in one or more portions of the previously broadcast interactive advertising content and responsive to the request data from the viewer, transmit the one or more indications of interest to the viewer.

In analogous art, Noll discloses an apparatus for controlling interactive television offerings over a transaction enabled broadcast or system operator with a central system or network operations center (NOC) or local processor collects information about viewer transactions for commerce purposes as the NOC processes the information (Page 3, paragraphs 0046-0048, Figure 17, Page 9, paragraph 0098, 0099, Page 10, paragraph 0106, 0107, Page 11, paragraph 0117, Page 5-6, paragraphs 0066, 0070, Figure 2a, 36). In analogous art, Bruckner discloses the central system processor or the broadcast station necessarily includes a processor as it performs all necessary functions to perform the process of adding interactive advertising content to non interactive advertising content for a period of time defined by at least one local merchant offer or local advertiser (Page 5, paragraph 0049-0052, 0058, Pages 6-7, paragraphs 0063,

0067 0079); wherein the non-interactive content is not originally created for interactivity as a commercial break includes non interactive commercials and interactive commercials and advertisers and broadcast station must have an agreement to initiate interactive triggers (Page 5, paragraphs 0050-0052, Page 6, paragraph 0063); wherein the at least one central system processor is further operative to route the request data to the at least one local merchant using at least one advertisement identifier (Page 5, paragraph 0050-0051, 0054-0058, Page 6, paragraph 0063). Bruckner discloses commercials with interactive content (Page 5, paragraph 0049-0052, 0058, Pages 6-7, paragraphs 0063, 0067, 0079). Barton discloses a pod of commercials or a commercial break (Figure 5). Barton discloses that adding interactive content of the commercial are placed at the last commercial of the group of commercials (Pages 2-3, paragraphs 0036-0037). Tomsen discloses the central system processor is further operative to collect and store previously broadcast interactive advertising content (Page 3, paragraph 0032, Page 4, paragraph 0037, 0039, 0040); wherein the central system processor is further operative to, responsive to the request data from the viewer, transmit the previously broadcast interactive advertising content to the viewer (Figure 3, Page 3, paragraph 0032, Page 4, paragraph 0037, 0039, 0040); wherein the central system processor is further operative to collect and store one or more indications of interest by the viewer in one or more portions of the previously broadcast interactive advertising content and responsive to the request data from the viewer, transmit the one or more indications of interest to the viewer (Figure 3, Page 3, paragraph 0032, Page 4, paragraph 0037, 0039, 0040).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerba to include network operations center (NOC) or local processor collects information about viewer transactions for commerce purposes (Page 3, paragraphs 0046-0048, Figure 17, Page 9, paragraph 0098, 0099, Page 10, paragraph 0106, 0107, Page 11, paragraph 0117, Page 5-6, paragraphs 0066, 0070, Figure 2a, 36) as taught by Noll for the benefit of targeting advertising and e-commerce material to the user (Page 1, paragraphs 0008, 0002) and for determining account balances and transactional information (Page 9, paragraph 0099) as disclosed by Noll. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include the central system processor is further operative to add interactive advertising content to non interactive advertising content for a period of time defined by at least one local merchant offer (Page 5, paragraph 0049-0052, 0058, Pages 6-7, paragraphs 0063, 0067 0079); wherein the non-interactive content is not originally created for interactivity as a commercial break includes non interactive commercials and interactive commercials and advertisers and broadcast station must have an agreement to initiate interactive triggers (Page 5, paragraphs 0050-0052, Page 6, paragraph 0063); wherein the at least one central system processor is further operative to route the request data to the at least one local merchant using at least one advertisement identifier (Page 5, paragraph 0050-0051, 0054-0058, Page 6, paragraph 0063) as taught by Bruckner in order to manage interactive content that may or may not be known in advance (Page 2, paragraph 0013) and to be able to sell advertising space to the highest bidder (Page 8,

paragraph 0078) and as disclosed by Bruckner. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include that important content can be added to the end of a group of commercials (Pages 2-3, paragraphs 0036-0037) as taught by Barton in order to have viewers watch more commercials (Page 1, paragraphs 0002, 0003) as disclosed by Barton. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include the central system processor is further operative to collect and store previously broadcast interactive advertising content (Page 3, paragraph 0032, Page 4, paragraph 0037, 0039, 0040); wherein the central system processor is further operative to, responsive to the request data from the viewer, transmit the previously broadcast interactive advertising content to the viewer (Figure 3, Page 3, paragraph 0032, Page 4, paragraph 0037, 0039, 0040); wherein the central system processor is further operative to collect and store one or more indications of interest by the viewer in one or more portions of the previously broadcast interactive advertising content and responsive to the request data from the viewer, transmit the one or more indications of interest to the viewer (Figure 3, Page 3, paragraph 0032, Page 4, paragraph 0037, 0039, 0040) as taught by Tomsen in order to allow a user to shop while watching television without the potential of losing interest (Page 1, paragraphs 0003-0004) as disclosed by Tomsen.

Moreover, in KSR v. Teleflex Co. No. 04-1350, slip. op. at 12 (U.S. April 30, 2007), the Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods

with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention.

Regarding Claim 2, Gerba, Noll, Bruckner, Barton and Tomsen disclose all the limitations of Claim 1. Noll discloses the broadcast content from a source comprises advertising content (Page 3, paragraph 0048).

Regarding Claim 3, Gerba, Noll, Bruckner, Barton and Tomsen disclose all the limitations of Claim 1. Gerba discloses broadcast content from broadcast source comprises program content (Column 6, lines 62-67).

Regarding Claim 4, Gerba, Noll, Bruckner, Barton and Tomsen disclose all the limitations of Claim 1. Gerba discloses central system processor of a MSO is further operative to add interactive content to the broadcast content (Figure 1, 12, 14, 16, 18, Column 9, lines 11-15).

Regarding Claim 5, Gerba, Noll, Bruckner, Barton and Tomsen disclose all the limitations of Claim 4. Bruckner discloses that interactive content is advertising content (Page 5, paragraph 0049-0052, 0058, Pages 6-7, paragraphs 0063, 0067, 0079).

Regarding Claim 6, Gerba, Noll, Bruckner, Barton and Tomsen disclose all the limitations of Claim 5. Bruckner discloses commercials with interactive content (Page 5, paragraph 0049-0052, 0058, Pages 6-7, paragraphs 0063, 0067, 0079). Gerba, Noll and Bruckner are silent on end of group of commercials. Barton discloses a pod of commercials or a commercial break (Figure 5). Barton discloses that important content

of the commercial are placed at the end of the group of commercials (Page 3, paragraph 0037) such as images or messages (Pages 2-3, paragraphs 0036-0037).

Regarding Claim 11, Gerba, Noll, Bruckner, Barton and Tomsen all the limitations of Claim 4. Bruckner discloses interactive content comprises a form to buy a car (Page 5, paragraph 0049-0052, 0058, Pages 6-7, paragraphs 0063, 0067, 0079). Tomsen disclose the added interactive content specifies local purchasing information (Page 2, paragraph 0022, Page 3, paragraph 0023, 0025).

Regarding Claim 12, Gerba, Noll, Bruckner, Barton and Tomsen discloses all the limitations of Claim 1. Noll discloses broadcast content from broadcast content source comprises interactive content (Page 3, paragraph 0047, Page 5, paragraphs 0067-0068).

Regarding Claim 17, Gerba, Noll, Bruckner, Barton and Tomsen disclose all the limitations of Claim 1. Gerba discloses the request data comprises a World Wide Web site and the central system processor of a MSO is further operative to redirect the website (Column 9, lines 7-15) via the internet server (Figure 1, 28). Bruckner discloses a World Wide Web site comprising a universal resource locator (URL) (Page 5, paragraph 0050-0051, 0058).

Regarding Claim 19, Gerba, Noll and Bruckner disclose all the limitations of Claim 17. Gerba discloses a controller or processor is operative to route request data from the viewer in response to interactive broadcast to the Internet (Figure 1, 28). Gerba, Noll and Bruckner are silent on routing to server for fulfillment. Tomsen discloses a method of conducting e-commerce over a transaction-enabled broadcast

network (Figure 1, 100, 134, Figure 2, 200, 108, 134); the method comprising: a broadcast receiving device (Figure 1, 152, Figure 2, 152) interacting with broadcast content to a provider receiving request data or transaction data over the network from a viewer (Page 3, paragraph 0026, Page 4, paragraph 0035), the request data being transmitted by the viewer in response to the broadcast content; and routing the request data to a local server for fulfillment (Page 4, paragraph 0035). The head-end processes all content to be broadcast and broadcasting (Page 2, paragraphs 0016, 0022, Page 4, paragraphs 0023-0025) and processes all requests and routing of requests (Page 3, paragraph 0026), which is maintained by the provider or cable system operator, which meets the limitations of creating broadcast content for broadcast over the network at a at least one central system processor, broadcasting broadcast content from the at least one central system processor receiving request data at a at least one central system processor, routing request data from the at least one central system processor (Page 3, paragraphs 0023-0026).

Regarding Claim 20, Gerba, Noll, Bruckner, Barton and Tomsen disclose all the limitations of Claim 1. Gerba discloses purchasing items based on programming (Column 1, lines 21-44). Gerba discloses a transaction database (Figure 1, 26). Noll discloses that the data based on commerce conducted by the viewer over the network is collected (Page 9, paragraphs 0098, 0099, Page 10, paragraphs 0107, 0109). Gerba, Tomsen disclose the memory is operative to store data based on commerce conducted by the viewer over the network (Page 3, paragraph 0032, Page 4, paragraphs 0037, 0039, 0040).

Regarding Claim 28, Gerba, Noll, Bruckner, Barton and Tomsen disclose all the limitations of Claim 1. Noll disclose the central system processor or components which perform processing of the NOC which includes an operator is further operative to associate a personal identification number (PIN) or user identification number (Page 9, paragraphs 0098-0099, Pages 5-6, paragraphs 0070, 0071, Page 11, paragraph 0112).

Regarding Claim 32, Gerba, Noll, Bruckner, Barton and Tomsen disclose all the limitations of Claim 1. Tomsen discloses the central system processor y operative to store at least one ship to address of the viewer (Page 3, paragraph 0032, Page 4, paragraphs 0037, 0039, 0040).

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerba in view of Noll, Bruckner, Barton and Tomsen as applied to claim 17 above, and further in view of Kenner et al (US 6,421,726 and hereafter referred to as "Kenner").

Regarding Claim 18, Gerba, Noll, Bruckner, Barton and Tomsen all the limitations of Claim 17. Gerba discloses the request data comprises a World Wide Web site and the central system processor of a MSO is further operative to redirect the website (Column 9, lines 7-15) via the internet server (Figure 1, 28). Bruckner discloses a World Wide Web site comprising a universal resource locator (URL) (Page 5, paragraph 0050-0051, 0058). Gerba, Noll, Bruckner, Barton and Tomsen are silent on reducing network congestion. Kenner discloses that the request data comprises a URL (Column 18, lines 48-65, Abstract). Kenner discloses a user is requesting web content from sites located in and around the Internet (Column 5, lines 63-65, Column 8,

lines 19-43). Kenner discloses that each individual user is routed to a delivery site that provides improved performance, which reduces network congestion (Column 6, lines 12-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include reducing network congestion (Column 6, lines 12-19) as taught by Kenner in order to improve the delivery of web content and link to further content and route to content quickly (Column 3, lines 38-65, Column 4, lines 15-22) as disclosed by Kenner.

6. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable Gerba in view of Noll, Bruckner, Barton and Tomsen as applied to claim 1 above, and further in view of Daly et al (US 5,878,141 and hereafter referred to as "Daly").

Regarding Claim 31, Gerba, Noll, Bruckner, Barton and Tomsen discloses all the limitations of Claim 1. Gerba discloses purchasing items based on programming (Column 1, lines 21-44). Tomsen discloses storing via the family safe or shopping cart the credit card information (Page 4, paragraph 0040). Gerba, Noll, Bruckner, Barton and Tomsen are silent on securely storing credit card information of the viewer. Daly discloses a broadcast receiving device (Figure 3, 46(1-m) operatively coupled to the network (Figure 3, 52, 54) and configurable to enable a viewer to interact with the broadcast (Figure 6, 208). Daly disclosed storing credit card system at the head server via the billing system and accounting system (Column 14, lines 4-10). Daly discloses that purchasing system or central system processor of a MSO (Figure 4, 74) for a secure communications of the purchase transaction needs a digital signature or certify

authority or MSO (Column 14, lines 11-25) to perform transactions so that fraudulent transactions do not occur (Column 16, lines 33-45), which reads on securely storing the credit card account information. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include credit card information is securely stored (Column 14, lines 4-25, Column 16, lines 33-45) as taught by Daly in order to allow a consumer to electronically pay for goods and services (Column 2, lines 40-42, 53-55) and to prevent fraudulent transactions (Column 15, lines 37-39) as disclosed by Daly.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FARZANA E. HOSSAIN whose telephone number is (571)272-5943. The examiner can normally be reached on Monday to Friday 7:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art
Unit 2623

FEH
September 29, 2008